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EXAMINER

HO, CHUONG T

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/353,537
Filing Date: July 14, 1999
Appellant(s): PANG, STEPHEN Y.F.

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GROUP 2600

Stephen Y.F. Pang
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 28, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

- Claims 1-10, 13-19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over McCormick et al. (U.S. Patent No. 6,023,723) in view of "Here is a zmail ban-spam button" (07 October 1997);
- Claims 11-12, 20 are rejected under 35 U.S.C. 103 (a) as being unpatentable over the combined system (McCormick – "Here is a zmail ban-spam button") in view of Courtney Macavinta (Staff Writer, CNET News.com "June 12, 1997).

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-10, 13-19 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 11-12, 20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,023,723

McCormick et al.

8-2000

John Gianni "Here is a zmail ban-spam button" (October 07, 1997) pages 1-7.

Courtney Macavinta "FTC search for spam solution" (June 12, 1997), pages 1-2.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1-10, 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick et al. (U.S. Patent No. 6,023,723) in view of "Here is a zmail ban-spam button" (07 October 1997).

In the claims 1, 13, McCormick et al. discloses a system for policing an unsolicited e-mail (filter junk e-mails)(see figure 3) comprising:

- ◆ a plurality of clients (17, 19), each coupled together using a wide area network (Internet and/or intranet 11) of computer comprising an Internet; a policy server (central e-mail system 21) coupled to each of the plurality of clients (17, 19) through the wide area network (Internet and/or intranet 11) of computers;
- ◆ the policy server being adapted to receive the indication (updated filter addresses) from the client to the policing server (see col.6, lines 33-38, col. 7, lines 45-48).

McCormick, however, does not disclose an icon on the display, the icon being adapted to send the indication from the client.

"Here is a zmail ban-spam button" (07 October 1997) discloses wherein the e-mail device comprises an SPAM icon (ban-spam button) on the display, the SPAM icon being adapted to send the indication from the client to the policing server (see "Here is a zmail ban-spam button", to ban repeat spam, you only needs the procmail steps below. The zmail steps simply provide a push-button interface to ban repeat spam).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the McCormick's system with the teaching of "Here is a zmail ban-spam button" to provide an option icon on the display in order to help the

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client to speed up removing the Junk mail (SPAM). Therefore, the modified system would have been enable the policy server being adapted updated e-mail filter in response to each client notification.

3. In the claims 2, 14, " Here is a zmail ban-spam button" discloses the policy server is adapted to report the unauthorized e-mail message (unwanted e-mail message) (see page 2, in fact, if someone does attempt to spam you twice, -- your system now automatically sends tem a system message response of "permission denied").

4. In the claims 3, 15, McCormick et al. discloses the policy server is adapted to updated a local e-mail filter for the client (25) in response to the unsolicited e-mail (see col. 4, lines 49-56).

5. In the claims 4, 16, McCormick et al. discloses each of clients (17, 19) comprises an updated e-mail filter from the policy server (central location 21) (see figure 3, col.4, lines 48-56).

6. In the claims 5, 17, McCormick et al. discloses the policy server comprises a log of the unsolicited e-mail (see figure 3, col.4, lines 48-56).

7. In the claim 6, McCormick et al. discloses the unsolicited e-mail message is SPAM (see figure 2, col.4, lines 8-14).

8. In the claims 7, 18, 19, McCormick et al. discloses the display comprises a browser program, the browser program being coupled to the e-mail device (see figure 3, web browser or e-mail access application).

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9. In the claim 8, McCormick et al. discloses each of the plurality of clients (17, 19) is for a different user, where each user is capable to sending the unsolicited e-mail message to the policy server (central location 21) (see col. 4, lines 49-56).

10. In the claim 9, McCormick et al. discloses the policy server (centralized server 21) comprises a plurality of SPAM filters (see figure 3, col.4, lines 49-56).

11. In the claim 10, McCormick et al. discloses each of clients (17, 19) is coupled to the wide area network (Internet 11) of computers through an Internet service provider (see figure 3).

12. In the claim 18, McCormick et al. discloses the client comprising an e-mail client program (19, figure 3).

13. In the claim 19, McCormick et al. discloses the client client comprising a browser program (see figure 3).

14. Claims 11-12, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system (McCormick - "Here is a zmail ban-spam button") in view of Courtney Macavinta (Staff Writer, CNET News.com "June 12, 1997").

In the claims 11, 20, the combined system (McCormick - "Here is a zmail ban-spam button") discloses the limitations of claim 1 above.

However, the combined system (McCormick - "Here is a zmail ban-spam button") is silent to disclosing the policing server is provided at a government authority.

Courtney Macavinta (Staff Writer, CNET News.com "June 12, 1997") discloses the FTC (Federal Trade Commission) made is clear that is already has the authority to crack down on junk emailer who engage in unfair or deceptive practice. The agency can

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obtain orders to shut down fraudulent mass marketing. It can also impose fines of up to \$11,000 of each act of contempt if a company fails to abide by an agreement with the agency to clean up its act (see page 1, lines 5-8); comprising:

- ◆ the policing server is provided at a government authority (see page 1, lines 5-8, the FTC (Federal Trade Commission) made is clear that is already has the authority to crack down on junk emailer who engage in unfair or deceptive practice. The agency can obtain orders to shut down fraudulent mass marketing. It can also impose fines of up to \$11,000 of each act of contempt if a company fails to abide by an agreement with the agency to clean up its act, see page 1, lines 25-26, member of the IMC (internet marketing council) will also have to offer customer to direct opt-out and comply with an ethics code that prohibits sending deceptive messages, see page 1, lines 27-28, it too calls for spammers to offer an opt-out choice. It also has an "email preference" option that allows consumers to remove their names from marketing email list, see page 1, lines 39-40, the bill aims to promote e-commerce by protecting consumer and ISP from bulk unsolicited email, giving the FTC (Federal Trade Commission) more authority to bust spammers who don't give an opt-out preference. It would make false return addresses illegal for commercial emailer, punishable by a fine of up to \$5,000).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system (McCormick - "Here is a zmail ban-spam button") with the teaching of to provide the policy server (which is provided at a government authority) in order to stop the junk email senders.

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15. In the claim 12, Courtney Macavinta (Staff Writer, CNET News.com "June 12, 1997") discloses the policing server is from an enforcement agency (Federal Trade Commission) (see page 1, lines 25-26, member of the IMC (internet marketing council) will also have to offer customer to direct opt-out and comply with an ethics code that prohibits sending deceptive messages, see page 1, lines 27-28, it too calls for spammers to offer an opt-out choice. It also has an "email preference" option that allows consumers to remove their names from marketing email list, see page 1, lines 39-40, the bill aims to promote e-commerce by protecting consumer and ISP from bulk unsolicited email, giving the FTC (Federal Trade Commission) more authority to bust spammers who don't give an opt-out preference. It would make false return addresses illegal for commercial emailer, punishable by a fine of up to \$5,000).

(11) Response to Argument

Claims 1,3,4,6-10,13,15,16,18 and 19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over McCormick et al. (U.S. Patent No. 6,023,723) in view of "Here is a zmail ban-spam button" (07 October 1997).

In the page 11, lines 18-20, the appellant alleged that "the term "policing server" is given a special meaning by the patentee: a policing server: a server that performs actions to reduce this incidence of further SPAM e-mail messages sent from one or more spammers"

McCormick et al. , see figure 1, discloses policing server (address filter server 22) that performs actions (see col. 3, lines 30-32, each of the users to prepare individualized dual filters to automatically prevent certain unwarranted e-mail from being received as

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well as to automatically receive desired e-mail) (see col. 3, lines 35-39, one of these filters is automatically updated by other users in the system when known unwanted e-mail addresses are determined. This software would also allow the individual to use a customer graphic user interface to assemble the filters) (see col. 4, lines 57-60, the data base server 24 in communication with address filter server 22 would download updated filter address to the various users in the system by constructing an address packet consisting of every address on the current filter list since the data and time of each of users last update) to reduce the incidence of further SPAM e-mail messages sent from one or more spammers.

In the Appeal's brief, pages 7-8, the appellant alleged that "neither McCormick nor Zmail, alone or in combination show or suggest the claimed policing server coupled to each of the plurality of clients through the wide are network of computers, as recited... such references also fail to show or suggest the further combination of the SPAM icon on the display, which is adapted to send the indication from the client to the policing server".

McCormick discloses claimed policing server (an address filtering server) coupled to each of the plurality of clients through the wide are network of computers; McCormick further shows updating of the banned addresses list (No Admittance list) by the user (see col. 2, lines 53-63); Note that McCormick discloses the user of a Trash Bin for discarding the e-mail whose address would have been to be added to the banned list (No Admittance list); (see figures 1, 3, see col. 6, lines 34-37, the address filter server

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22 (policing server) would relay e-mail filter user requests to the filter database of the database server 24 and meeting appropriate calls via RPC of a library on the database server);

What Mc Cormick does not show is SPAM Icon.

John Gianni "Here is a zmail ban-spam button" (07 October 1997) discloses SPAM icon on the display (see page 1, to ban repeat spam, you only needs the procmail steps below. The Zmail steps simply provide a push-button interface to ban repeat spam....Add a push-button interface to Zmail to ban spam automatically) (see page 2, then whenever you get spammed, simply press the Zmail Message-window [Ban} button, which automatically adds the spammer's address into the "banned" file (the log file) ensuring that the spammer will never ever spam you twice. In fact, if someone does attempt to spam you twice, -- your system now automatically sends tem a system message respone of "permission denied") (in page 4, Add a push-button interface to Zmail append spam address automatically).

Clearly, both McCormick, Zmail, alone or in combination show or suggest the claimed policing server coupled to each of the plurality of clients through the wide are network of computers, as recited... such references (McCormick and Zmail) show or suggest the further combination of the SPAM icon on the display, which is adapted to send the indication from the client to the policing server".

In the claims 2, 4, see page 12, lines 14-16, Appellant alleged that the policing server is not the same as the spammer. The Appellant's argument is not persuasive. John

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Gianni "Here is a zmail ban-spam button" (07 October 1997) discloses the policing server is adapted to report the unauthorized e-mail message (see page 2, In fact, if someone does attempt to spam you twice, -- your system now automatically sends a system message response of "permission denied").

In the claims 5, 17, Appellant alleged that "McCormick fails to show or suggest that the policing server comprises a log of the unsolicited e-mail communication as recited by claim 5. The Appellant's argument is not persuasive.

Appellant remember that claims 5,7 are reject under 35 U.S.C. 103 (a) as being unpatentable over McCormick et al. (U.S.Patent No. 6,023,723) in view of "Here is a zmail ban-spam button" (07 October 1997).

McCormick discloses policing server comprises a log of the unsolicited e-mail (No Admittance list) communication (see figure 1, col. 4, lines 8-14, the "No Admittance List" would be a list of terms and addresses included to create the automatic discard filter... Any e-mail received by the user is checked against the automatic discard filter 12 to determine whether any characters string on the "No Admittance List" 52 will bar entry of any e-mail with matching text in its address, subject line or message body).

John Gianni "Here is a zmail ban-spam button" (07 October 1997) discloses a log of the unsolicited e-mail (see page 2, then whenever you get spammed, simply press the Zmail Message-window [Ban] button, which automatically adds the spammer's address into the "banned" file (the log file)).

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Clearly, both McCormick, John Gianni "Here is a zmail ban-spam button" (07 October 1997) discloses a policing server comprises a log of the unsolicited e-mail.

Claims 11-12, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system (McCormick - "Here is a zmail ban-spam button") in view of Courtney Macavinta (Staff Writer, CNET News.com "June 12, 1997").

In the page 13, lines 25-26, Appellant alleged that "nothing in Courtney teaches the government authority having policing server".

The Appellant's argument is not persuasive.

Courtney discloses "the government authority having policing server (The policing server is provided at a government authority (see page 1, lines 5-8, the FTC (Federal Trade Commission) made is clear that is already has the authority to crack down on junk emailer who engage in unfair or deceptive practice. The agency can obtain orders to shut down fraudulent mass marketing. It can also impose fines of up to \$11,000 of each act of contempt if a company fails to abide by an agreement with the agency to clean up its act, see page 1, lines 25-26, member of the IMC (internet marketing council) will also have to offer customer to direct opt-out and comply with an ethics code that prohibits sending deceptive messages, see page 1, lines 27-28, it too calls for spammers to offer an opt-out choice. It also has an "email preference" option that allows consumers to remove their names from marketing email list, see page 1, lines 39-40, the bill aims to promote e-commerce by protecting consumer and ISP from bulk unsolicited email, giving the FTC (Federal Trade Commission) more authority to bust

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spammers who don't give an opt-out preference. It would make false return addresses illegal for commercial emailer, punishable by a fine of up to \$5,000).

Both McCormick, John Gianni "Here is a Zmail ban-spam button", Courtney discloses SPAM "Junk mail". Courtney discloses The policing server is provided at a government authority (see page 1, lines 5-8, the FTC (Federal Trade Commission) made is clear that is already has the authority to crack down on junk emailer who engage in unfair or deceptive practice. The agency can obtain orders to shut down fraudulent mass marketing. It can also impose fines of up to \$11,000 of each act of contempt if a company fails to abide by an agreement with the agency to clean up its act. Clearly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system (McCormick - "Here is a zmail ban-spam button") with the teaching of to provide the policy server (which is provided at a government authority) in order to stop the junk email senders.

For the above reasons, it is believed that the rejections should be sustained.


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May 2, 2005


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Respectfully submitted,



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